

FAX RECEIVED

JUN 2002

GROUP 1600

#10  
6/5/02  
M. M. M.  
OFFICIAL

OFFICIAL

OFFICIAL

PATENT

Our Docket: P-HP 3808

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Watson-Straughan et al.

Serial No: 09/632,928

Filed: August 4, 2000

For: TRIAMINE DERIVATIVE  
MELANOCORTIN RECEPTOR  
LIGANDS AND METHODS  
OF USING SAME

Commissioner for Patents  
Washington, D.C. 20231

Group Art Unit: 1621

Examiner: S. Barts

I hereby certify that this correspondence  
is being transmitted with the United  
States Patent and Trademark Office by  
facsimile on May 31, 2002.

By: David I. Spolter  
David I. Spolter, Reg. No. 36,933

May 31, 2002  
Date of Signature

RESPONSE TO OFFICE ACTION

Responsive to the Office Action mailed April 23,  
2002, entry of the following Remarks is respectfully  
requested. A response was initially due by May 23, 2002.  
However, a petition for extension, requesting an extension  
of one month, or until June 23, 2002, along with the  
corresponding extension fee, is submitted herewith.  
Accordingly, this response is timely filed.

Response to Office Action  
App. Ser. No. 09/632,928  
Page 2

**Regarding the restriction requirement.**

The Action further restricts the claims into two additional groups:

- I. Claims 1 to 19, directed to compounds; and
- II. Claim 42, directed to compositions.

In response to the restriction, Applicants elect Group I, claims 1 to 19, directed to compounds.

However, Applicants respectfully traverse the restriction and request that original Groups I and II be rejoined. As will be recalled, originally the claims were restricted into two groups, 1) claims 1 to 19 and 42, directed to compounds; and 2) claims 20 to 41, directed to methods of treatment. As a basis for this restriction, citing MPEP sec. 806.05(h), the previous Office Action alleged that the claimed product can be used in a materially different process of using that product.

In response, Applicants respectfully pointed out that MPEP sec. 806.05(h) also states that "The burden is on the examiner to provide an example" of such a method. The previous Office Action, as well as the current one, provides no such example. Accordingly, no proper basis for the original restriction is provided and, therefore,

Response to Office Action  
App. Ser. No. 09/632,928  
Page 3

**rejoinder of original Groups I and II is respectfully requested.**

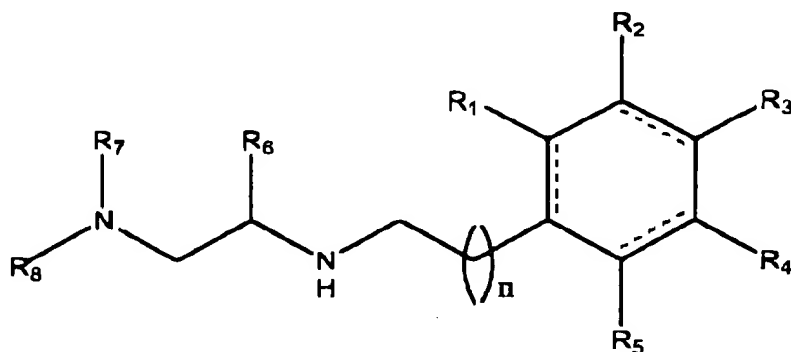
Alternatively, because no example of a materially different method is provided in either this or the previous Action, as it must, Applicants respectfully request that one method be rejoined with the elected Group I of compounds. Specifically, Applicants request rejoining the claims directed to methods of altering the activity of a melanocortin receptor, claims 20 to 30.

Additionally, Applicants wish to acknowledge that the present Office Action states that once a genus or subgenus of compounds is found allowable, the Examiner will rejoin a composition claim (i.e., the full breadth of claim 42, as originally filed) of corresponding scope of what is allowed.

**Regarding the species election.**

Having elected, with traverse, Group I for examination, Applicants wish to remind the Examiner of the election of species, specifically, the formula shown in claim 1,

Response to Office Action  
App. Ser. No. 09/632,928  
Page 4



wherein:

R<sub>1</sub>, R<sub>2</sub>, R<sub>4</sub>, R<sub>5</sub> and R<sub>7</sub> are hydrogen;

R<sub>3</sub> is chloro;

R<sub>6</sub> is (4-iodophenyl)methyl;

R<sub>8</sub> is the formula X-CH-Y, wherein the adjoining nitrogen depicted in the formula of claim 1 is directly attached to the carbon atom of the formula X-CH-Y, and wherein:

X is 3-guanidinopropyl; and

Y is aminomethyl; and

n is 1.

Response to Office Action  
App. Ser. No. 09/632,928  
Page 5

CONCLUSION

In light of the Remarks herein, Applicants respectfully submit that the claims are now in condition for allowance and requests a notice to this effect. Should the Examiner have any questions, he is invited to call the undersigned attorney.

Respectfully submitted,

Date: May 31, 2002

David I. Spolter

David I. Spolter

Registration No. 36,933

Telephone No. (858) 459-2934

Facsimile No. (858) 459-0698

LAW OFFICE OF DAVID SPOLTER  
1590 Coast Walk  
La Jolla, California 92037